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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,268	10/29/2003	Sang-Nyun Kim	4084-032129	6488

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EXAMINER

RUSSEL, JEFFREY E

ART UNIT PAPER NUMBER

1654

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/696,268

Applicant(s)

KIM ET AL.

Examiner

Jeffrey E. Russel

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,10 and 11 is/are rejected.
- 7) ☒ Claim(s) 3-9 and 12-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Claims 6-9 and 15-18 are objected to because of the following informalities: At claims 6-9, line 2 of each claim, the end bracket is unmatched. Appropriate correction is required.

2. The effective filing date of instant claims 1, 2, 6-11, and 15-18 is deemed to be October 29, 2003, the filing date of the instant application. Instant claims 1, 2, 6-11, and 15-18 are not deemed to be entitled under 35 U.S.C. 120 to the benefit of the filing date of parent application 10/141,723 because the parent application '723, under the test of 35 U.S.C. 112, first paragraph, does not disclose the full range of the R groups recited in instant claim 1, and does not disclose the alkylthio, benzylthio, 4-nitrophenylthio, or dimethylthiocarbamyl R groups recited in instant claims 2 and 6-9. Because the inventorship of WO Patent Application 2002/92032 is different than the inventorship of the instant claims, WO Patent Application 2002/92032 is available as prior art against instant claims 1, 2, 6-11, and 15-18 under 35 U.S.C. 102(a).

The effective filing date of instant claims 3-5 and 12-14 is deemed to be May 9, 2002, the filing date of parent application 10/141,723. Instant claims 3-5 and 12-14 are deemed to be entitled under 35 U.S.C. 120 to the benefit of the filing date of the parent application '723 because the parent application '723, under the test of 35 U.S.C. 112, first paragraph, discloses the claimed invention.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 2, 10, and 11 are rejected under 35 U.S.C. 103(a) as being obvious over the WO Patent Application 2002/92032. The WO Patent Application '032 is equivalent to U.S. Patent No. 6,790,830 applied above, and the WO Patent Application '032 suggests claims 1, 2, 10, and 11 for the same reasons that U.S. Patent No. 6,790,830 suggests these claims.

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The '830 patent claims a method for treating alopecia and for promoting hair growth by administering a composition comprising 3-position analogs of cyclosporin. The 3-position residue of the claimed analogs can be of General formula 2, and when x is S, then R<sup>2</sup> can be C<sub>2</sub> - C<sub>6</sub> straight or branched alkyl, alkenyl or alkynyl moieties, substituted or unsubstituted with one or more selected from the group consisting of amino, hydroxy, halo, haloalkyl, ester, alkoxy, cyano, nitro, alkylamino, and dialkylamino. The '830 patent does not specifically claim such 3-position analogs in which no other residue of the cyclosporin analog is altered. It would have been obvious to one of ordinary skill in the art to use such 3-position analogs in the claimed method of the '830 patent because the claims of the '830 patent generically encompass such 3-position analogs, because the preferred 3-position analogs claimed in the '830 patent do not alter any other residue of the cyclosporin, because one skilled in the art would alter the minimum number of residues possible in order to maintain the activity of the basic peptide, and because such analogs have only the hair growth promoting activity which would have been expected in view of the claims of the '830 patent.

5. Applicant's arguments filed March 17, 2005 have been fully considered but they are not persuasive.

The terminal disclaimer filed March 17, 2005 has been approved.

Applicants' statement at page 8, first and second paragraphs, of the response satisfies the requirement set forth in section 5 of the first Office action and is sufficient under 35 U.S.C. 103(c) to overcome the obviousness rejection set forth in section 7 of the first Office action.

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The translation of the foreign priority document referred to at page 7, last paragraph, of Applicants' response has not yet been received. Accordingly, the obviousness rejection over the WO Patent Application 2002/92032 is maintained.

6. Claims 3-5 and 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 6-9 and 15-18 would be allowable if rewritten or amended to overcome the claim objections set forth in this Office action.

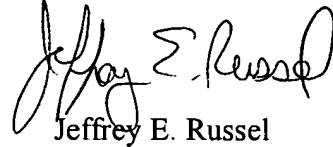
7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (571) 272-0969. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Bruce Campell can be reached at (571) 272-0974. The fax number for formal communications to be entered into the record is (571) 273-8300; for informal communications such as proposed amendments, the fax number (571) 273-0969 can be used. The telephone number for the Technology Center 1600 receptionist is (571) 272-1600.



Jeffrey E. Russel

Primary Patent Examiner

Art Unit 1654

JRussel

April 28, 2005